Decision for dispute CAC-UDRP-106095

Case number	CAC-UDRP-106095
Time of filing	2023-12-21 09:16:10
Domain names	reportingjcdecaux.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	JCDECAUX SE

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	dr. Meszaros Alexandra

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:

- the International trademark JCDECAUX (registration n°803987) dated November 27, 2001.

Moreover, the Complainant is also the owner of the domain names bearing the sign “JCDECAUX” such as the domain name <jcdecaux.com> registered since June 23, 1997.

FACTUAL BACKGROUND

The Complainant, JCDECAUX SE, is a company operating worldwide in outdoor advertising including street furniture, transport advertising and billboard since 1964. It has more than 1,042,132 advertising panels in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture.

The Complainant holds the trademark registration “JCDECAUX” and domain name bearing “JCDECAUX”.

On December 15, 2023; the Respondent registered the disputed domain name <reportingjcdecaux.com>. It redirects to the host parking page.

PARTIES CONTENTIONS

COMPLAINANT:

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Complainant explains that the disputed domain name is confusingly similar to the Complainant's trademark "JCDECAUX" as it bears the Complainant's "JCDECAUX" trademark as a whole with the addition of the generic term "REPORTING", which is not sufficient to avoid likelihood of confusion. The Complainant states that the GTLD is viewed as a standard registration requirement and as such is disregarded.

The Complainant refers to earlier panel decisions including WIPO Case No. D2003-0888 (Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin), where it was stated that a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP, as well as WIPO Case No. D2006-0451 (F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.), where was also stated that it is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

Finally, the Complainant claims that past panels have confirmed the Complainant's rights over the term "JCDECAUX" such as in CAC Case No. 102169 (JCDECAUX SA v. dre dre <jicdecaux.com>), CAC Case No. 101990 (JCDECAUX SA v. Gemma Purnell <jcdeceux.com>) and CAC Case No. 101961 (JCDECAUX SA v. dre dre <jcdiecaux.com>).

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent is not identified in the WHOIS database as the disputed domain name and past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is claimed to be not known as the disputed domain name.

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither licence nor authorization has been granted to the Respondent by the Complainant to make any use of the Complainant's trademark JCDECAUX, or apply for registration of the disputed domain name.

Furthermore, it was stated that the disputed domain name is on hosting parking page. The Complainant contends that the Respondent did not make any use of disputed domain name, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. It is claimed to prove a lack of legitimate interests in respect of the disputed domain name except in order to create a likelihood of confusion with the Complainant and its trademark. Therefore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant asserts that its trademark JCDECAUX was already known for decades and protected in several countries at the time of the registration and also the Complainant is doing business in more than 80 countries worldwide and is listed at the Euronext Paris stock exchange.

Besides, the Complainant stated that past panels have held that the JCDECAUX trademark is well-known and referred to WIPO Case No. DCC2017-0003 (JCDecaux SA v. Wang Xuesong, Wangxuesong), where the Panel was satisfied that the Respondent must have been aware of the Complainant's well-known JCDECAUX trade mark when it registered the disputed domain name.

The Complainant further pointed out that most result of a Google search on the terms "REPORTING JCDECAUX" refer to the Complainant.

Thus, given the distinctiveness of the Complainant's trademark and reputation, the Complainant claims that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark JCDECAUX, and could not possibly ignore the Complainant.

Furthermore, it was stated that the disputed domain name redirects to a hosting parking page. The Complainant argues that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

The Complainant also referred to the prior WIPO UDRP decisions where panels have held that the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. The following prior WIPO UDRP panels were provided as examples, where it was held that the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use:

- WIPO Case No. D2000-0003 (Telstra Corporation Limited v. Nuclear Marshmallows)

- WIPO Case No. D2000-0400 (CBS Broadcasting, Inc. v. Dennis Toeppen)

Finally, the Complainant asserts that the disputed domain name has been set up with MX records, which suggests that it may be actively used for e-mail purposes. This is claimed to be also indicative of bad faith registration and use because any e-mail emanating from the disputed domain name could not be used for any good faith purpose. The Complainant referred to the previous case of CAC Case No. 102827 (JCDECAUX SA v. Handi Hariyono), where it was decided that there was no present use of the disputed domain name but there are several active MX records connected to the disputed domain name and it was inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

The Respondent contacted the CAC via email on January 24, 2024 (14 days after lapse of Respondent´s time period to provide a Response) requesting CAC´s assistance. The CAC replied to the Respondent and no further communication of the Respondent was received.

Respondent claims the following:

“I just found out about the procedure because it was only in the spam folder of the contact e-mail address, I just read it by accident.

They cannot comment on the procedure in any way, nor do I know the specific reasons.

The domain provider has not reported any problems, and the domain name 'jcdecauxreporting.com' was created by JCDecaux Hungary Zrt. as a platform for reporting complaints.

It is also listed on the website of JCDecaux Hungary Zrt. as a contact address, we are entitled to use the name of the company, the owner of the company has explicitly agreed (as it is the name of the Hungarian company itself).

Please help us with what to do next, given that the domain contact could be created without any problems and that we have not committed any infringement by using the name.”

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents

submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

1. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of “JCDECAUX” trademark.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s “JCDECAUX” trademark and the addition of the non-distinctive word “REPORTING” is not sufficient to vanish the similarity.

Moreover, the addition of the gTLD “.COM” is not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complainant and any use of the trademark “JCDECAUX” has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name.

The Respondent in the email does not provide any evidence of rights ownership, it simply states that some Hungarian company agreed with use of the name, but did not provide any register nor the consent of a company with such name. The Complainant denies any connection to the Respondent.

The Panel accepts the Complainant’s allegations as true that the Respondent has no authorization to use the Complainant’s trademark in the disputed domain name.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain dame, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel concludes that the Complainant's “JCDECAUX” trademark is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the “JCDECAUX” trademark, the Respondent, was aware of the Complainant and its trademark at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant’s trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the disputed domain name <reportingjcdecaux.com> is currently inactive and resolves to a parking page. Regarding inactive domain names, section 3.3 of the WIPO Overview 3.0 provides the following: “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.” Besides, although there is no present use of the disputed domain name, the fact that there is MX record connected to the disputed domain name suggests that the Respondent will not be able to make any good faith use of the disputed domain name as part of an e-mail address.

The Respondent did not provide any evidence of any possible good faith use of the disputed domain name.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **reportingjcdecaux.com**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2024-01-24

Publish the Decision